

### REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested. The applicant has amended the specification, abstract and claims as suggested by the Examiner.

After entry of the foregoing Amendment, claims 1-19 are pending in the present Application. Claims 12, 13, 15, 17 and 19 have been amended. No new matter has been added.

By way of summary, the Official Action presents the following issues: the Abstract of the Disclosure stands objected to; the Specification stands objected to; Claim 13 stands objected due to informalities; Claims 12, 15, 17, and 19 stand rejected under 35 U.S.C. § 112, second paragraph; Claims 1-12 and 14-19 stand rejected under 35 U.S.C. § 102 as being anticipated by Meininger et al. (U.S. Patent No. 3,888,862 (hereinafter Meininger)); Claim 13 stands objected to as being dependent upon a rejected base claim;

### OBJECTION TO THE ABSTRACT OF THE DISCLOSURE

The outstanding Official Action has objected to the Abstract of the Disclosure because it has reference to the claims. The applicant has amended the abstract as suggested by the Examiner. For the above reasons, this objection should be withdrawn.

### OBJECTION TO THE SPECIFICATION

The outstanding Official Action has objected to the Specification allegedly as failing to provide proper antecedent basis. The applicant has amended the specification

as suggested by the Examiner. For the above reasons, this objection should be withdrawn.

### **OBJECTION TO CLAIMS**

The outstanding Official Action has rejected Claim 13 due to informalities. Applicants have amended Claim 13 pursuant to the Examiner's recommendation and respectfully request this objection to Claim 13 be withdrawn.

The outstanding Official Action has rejected Claim 13 as being dependent upon a rejected base claim, but states that it would be allowable if rewritten in independent form.

### **REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

The outstanding Official Action has rejected Claims 12, 15, 17, and 19 under 35 U.S.C. § 112, second paragraph. The applicant has amended these claims as suggested by the Examiner. For the above reasons, this rejection should be withdrawn.

### **REJECTION UNDER 35 U.S.C. § 102**

The outstanding Official Action has rejected Claims 1-12 and 14-19 under 35 U.S.C. § 102 as being anticipated by Meininger. The Examiner seems to base the rejection basically on the disclosure on column 10, lines 47-57 of Meininger. According to which the dyestuffs of Meininger may be used according to the dyeing and printing methods commonly used in the art for reactive dyestuffs. Obviously, Examiner summarizes textile inkjet printing under "commonly used printing methods".

However, textile inkjet printing was not a commonly used printing method on June 30, 1972 (the filing date of Meininger) and a person of ordinary skill in the art would not understand this method as being covered by Meininger's disclosure.

Enclosed is a publication of Smith and Simonson of August 1987. They report on the first page, left column that a method using streams of dye have been employed for low resolution end-uses, such as carpets (reference to (4) of 1977) and that high resolution ink jet printing is an emerging technology(in 1987!!). According to this publication inkjet printing was in no case a commonly used printing method in 1972 but developed about one decade later.

Terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); *Catalina Mktg. Int'l., Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) ([A] preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim.). Although no "litmus test" exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. *Id.* (citing *Corning Glass Works v. Sumitomo Electric USA, Inc.*, 868 F.2d 1252, 1257 (Fed. Cir. 1989). Accordingly, the PTO has allowed preamble language to be relied upon to distinguish an invention from the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1347-48 (Fed. Cir. 2002). Read in light of the specification, the claims of the present application clearly describe **an aqueous textile inkjet printing ink.**

Furthermore, applicant's specification indicates that the claims are directed at aqueous textile inkjet printing inks specifically. Addressing facts very similar to those herein, the Federal Circuit held that where the preamble recites additional structure or steps that the specification deems important, the preamble may limit the claims. *See Corning Glass*, 868 F.2d at 1257. In *Corning Glass* the claim in question read: "An optical wave guide comprising..." The specification later went on to define "optical wave guide." The court held that the preamble limited the claim to optical wave guides because "optical wave guide" was later defined in the specification. *Id.*

Similarly, the present invention's specification defines and describes the characteristics of an aqueous textile inkjet printing ink at page 1, line 6 through page 2, line 14; page 11, lines 8-15; page 12, lines 5-8; and the examples of the instant specification. It is clear that the definition and characteristics of an aqueous textile inkjet printing ink is important to an understanding of what was claimed and as a result the preamble should be given weight.

Here, the preamble of claim 1 contains the phrase "aqueous textile inkjet printing inks". For the above reasons, this rejection should be withdrawn.

### **CONCLUSION**

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present Application, including Claims 1-19, is patently distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.

**A two month extension fee has been paid.** If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 C.F.R. 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775 under Order No. 05579-00351-US from which the undersigned is authorized to draw.

Respectfully submitted,

CONNOLLY, BOVE,  
LODGE & HUTZ, L.L.P.

A handwritten signature in black ink, appearing to read "Ashley I. Pezzner". The signature is fluid and cursive, with the first name "Ashley" and last name "Pezzn" being clearly legible, followed by a stylized "er".

Ashley I. Pezzner  
Registration No. 35,646  
Attorney of Record

CUSTOMER NUMBER

**23416**

Phone: 302-658-9141

Fax: 302-255-4270

AIP:yes

Enclosure: Smith and Simonson of August 1987